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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,304	10/15/2004	Takao Koyama	009682-138	9491

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EXAMINER

NGUYEN, TUAN N

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/511,304

Applicant(s)

KOYAMA, TAKAO

Examiner

Tuan N. Nguyen

Art Unit

3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-58 is/are pending in the application.
- 4a) Of the above claim(s) 22-36, 38-50, 52, 54, 56 and 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21, 37, 51, 53, 55 and 57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/15/04, 7/19/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election of Species 1: Fig. 1 in the reply filed on 7/10/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). The applicant further indicates claims 21, 37, 51, 53, 55 and 57 are readable thereon. Accordingly, claims 22-36, 38-50, 52, 54, 56 and 58 are withdrawn from further consideration.

Specification

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 21, 37, 51, 53, 55 and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear as to how far the applicant wants to refer back in the disclosure with the language "described above" on lines 3 and 5-6 of claim 21. Furthermore, it is unclear as to what claim 37 is claiming.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21 and 37 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Quercioli.

Quercioli discloses a writing instrument in which an ink impregnated into an ink occlusion body (14) in a barrel (3) is fed to a pen tip (9a) in a writing part, wherein the ink impregnated into the ink occlusion body is fed to the pen tip via an ink guiding feed (9) having visibility since barrel (3) is made of transparent material, and a sign of exhausting the ink fed from the ink occlusion body is inherently detected by visually observing the ink guiding feed described above via a visible part formed in the barrel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21, 37, 51, 53, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirita in view of Takanashi et al. (hereinafter Takanashi) and Madaus et al. (hereinafter Madaus).

In regard to claims 21 and 37, Kirita discloses a writing instrument (Fig. 1) in which an ink impregnated into an ink occlusion body (101) in a barrel (100) is fed to a pen tip (12) in a writing part, wherein the ink impregnated into the ink occlusion body is fed to the pen tip via an ink guiding feed (12a) having visibility since it is made of transparent material. Although the Kirita reference is silent as to the material of the barrel being made out of transparent material, attention is directed to the Takanashi reference which discloses an analogous writing instrument, which further includes a barrel (12) and an ink guiding feed (18) made out of transparent material (see col. 8, lines 11-16) so as to check not only the residual ink quantity in the ink tank but also that in the collector (see col. 5, line 64 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the barrel of Kirita out of transparent material as, for example, taught by Takanashi in order to check not only the residual ink quantity in the ink tank but also that in the ink guiding feed area. In so doing, a sign of exhausting the ink fed from the ink occlusion body is inherently detected by visually observing the ink guiding feed via a visible part formed in the barrel. In regard to claim 51, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make only a portion of the barrel visible as claimed in a way similar to the portion (10) in Fig. 4 of Madaus. In regard to claims 53, 55 and 57, although the Kirita reference is silent of the specific dimension of the ink guiding feed having an ink passage, the specific surface tension of the ink, and the specific viscosity of the ink as claimed, it would have been obvious to one of ordinary skill in the art at the time the invention was made to obtain an ink guiding feed having

an ink passage cross-sectional area in the specific range as claimed and an ink having the specific surface tension and viscosity as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art.

Conclusion


6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Iida discloses a writing instrument with transparent barrel and ink guiding feed; and Sukhna et al. discloses an ink with a specific surface tension.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan N. Nguyen whose telephone number is 571-272-4892. The examiner can normally be reached on Monday-Friday (10:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine R. Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Tuan Nguyen
Primary Examiner
Art Unit 3751
9/30/06

TN